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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,489	02/22/2002	Bernd Niethammer	01-0401	9328

7590 03/05/2004

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EXAMINER

SOLAK, TIMOTHY P

ART UNIT

PAPER NUMBER

3746

DATE MAILED: 03/05/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/079,489	NIETHAMMER, BERND <i>101</i>
	Examiner	Art Unit
	Timothy P. Solak	3746 <i>101</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 February 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 8-13 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 8,9 and 13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

FINAL ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-9 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson et al. (5,678,521). Thompson et al. teach a multiple stage pump for use in a hydraulically controlled fuel injector system comprising: (*identical parts have been given the same numbers in Figure 1, the terms left and right have been added to distinguish the separate entities*) at least two pumps (14 right and 14 left), at least two valve means (18/36 right and 19/36 left) for regulating fluid from said at least two pumps, respectively, the at least two valve means being upstream from the at least two pumps in a respectively same line as the at least two pumps (see Figure 1), wherein the at least two valve means includes: a first check valve (36 right) upstream from a first pump (14 right) of the at least two pumps and a first valve (19) of the at least two valves, and a second check valve (36 left) upstream from a second pump (14 left) of the at least two pumps and a second valve (18) of the at least two valves. Thompson et al. further teach a merge line (12) upstream (see Figure 1) of the at least two valve means and the valve means are each a set (18/36 right and 19/36 left) of valves.

Claims 8-9 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamamoto (5,197,438). Yamamoto teaches a multiple stage pump for use in a hydraulically controlled fuel injector system comprising: at least two pumps 14, at least two valve means 20/30a and 20/30b for regulating fluid from said at least two pumps, respectively, the at least two valve means being upstream from the at least two pumps in a respectively same line as the at least two pumps (see Figure 2), wherein the at least two valve means includes: a first check valve 20 upstream from a first pump 14 of the at least two pumps and a first valve 30a of the at least two valves, and a second check valve 20 upstream from a second pump 14 of the at least two pumps and a second valve 30b of the at least two valves. Yamamoto further teaches a merge line 4 upstream (see Figure 2) of the at least two valve means and the valve means are each a set 20/30a and 20/30b of valves.

Response to Arguments

Applicant's arguments with respect to Claims 8-9 and 13, in view of Gray, have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that a hydraulic water system is different than a hydraulic fuel system, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument, "there would be no requirement to include gate valves on both the upstream and downstream side of the pump" (page 4, first paragraph), the use of valves in a hydraulic pumping system is well known and documented. It was old and well known in the art of pump fabrication, that a common hydraulic system requires valves to function. This well known fact encompasses control valves, gate valves, check valves, needle valves, and a host of other type of valves to numerous to mention; arranged in either double or single valve formations. Ordinary valves in a hydraulic system advantageously facilitated maintenance of the system and the more valves the better. Whether the valves are used to control the flow or isolate the system, are functional or just installed for future expansion of the system, an argument that "there is no requirement to include a gate" valve or any other type of valve in a simple hydraulic system is not persuasive.

In response to applicant's argument directed towards "variable pressure applications", "steady state control and smooth transition" (page 4, first paragraph), it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With respect to applicant's request to rejoin Claim 10-12, this issue is deferred until a discovery of allowable subject matter is made.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Takahashi (5,176,120) teaches a fuel pump 45 with a control valve 52 and a check valve located downstream of the pump.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy P. Solak whose telephone number is 703-308-6197. The examiner can normally be reached on Monday through Thursday from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 703-308-2675. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.


JUSTINE YU
SUPERVISORY PATENT EXAMINER

2/24/04


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February 23, 2004